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ID

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/442,111	11/17/99	DEFREES	S 14137-013820

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EXAMINER

FRONDA, C

ART UNIT	PAPER NUMBER
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1652

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DATE MAILED:

06/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/442,111

Applicant(s)
Defrees et al.

Examiner
Christian L. Fronda

Group Art Unit
1652



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-71 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-71 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-27, drawn to a reaction mixture comprising an acceptor saccharide and a first type of plant or microorganism cell that produces a nucleotide sugar and a first recombinant glycosyltransferase, classified in class 435, subclass 252.3.
 - II. Claims 28-30, drawn to a reaction mixture comprising an acceptor saccharide and a first type of plant or microorganism cell comprising a nucleotide sugar, a first recombinant glycosyltransferase, an enzymatic system for producing at least a second nucleotide sugar, and a second recombinant glycosyltransferase, classified in class 435, subclass 252.3.
 - III. Claims 31-39, drawn to a reaction mixture comprising an acceptor saccharide, a first type of plant or microorganism cell that produces a nucleotide sugar and a first recombinant glycosyltransferase, and a second type of cell that produces a second nucleotide sugar, and a second recombinant glycosyltransferase, classified in class 435, subclass 252.3.
 - IV. Claims 40-71, drawn to a cell comprising a recombinant gene encoding a glycosyltransferase, an enzymatic system for forming a nucleotide sugar, and an exogenous saccharide acceptor moiety; and methods for making a product saccharide using said cell, classified in class 435, subclass 101.
2. The inventions are distinct, each from the other because of the following reasons:

Each of groups I, II, III, and V is directed to a separate and distinct invention. Group I is directed toward to a reaction mixture comprising an acceptor saccharide and a first type of plant or microorganism cell that produces a nucleotide sugar and a first recombinant glycosyltransferase; group II is directed toward a reaction mixture comprising an acceptor saccharide and a first type of plant or microorganism cell comprising a nucleotide sugar, a first recombinant glycosyltransferase, an enzymatic system for producing at least a second nucleotide sugar, and a second recombinant glycosyltransferase; group III is directed toward a reaction mixture comprising an acceptor saccharide, a first type of plant or microorganism cell that produces a nucleotide sugar and a first recombinant glycosyltransferase, and a second type of cell that produces a second nucleotide sugar, and a second recombinant glycosyltransferase; and group IV is directed toward a cell comprising a recombinant gene encoding a glycosyltransferase, an enzymatic system for forming a nucleotide sugar, and an exogenous

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saccharide acceptor moiety; and methods for making a product saccharide using said cell. The products of groups I, II, III, and V, respectively, would be expected to have distinct functional, chemical, and physical properties. These products are capable of separate manufacture, use, or sale, and are patentable over each other.


3. A telephone call was made to Timothy Smith on June 22, 2000, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF
June 27, 2000


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600